

## REMARKS

Initially, the Examiner identified two patentably distinct invention, identified as Group I, associated with claims 1-37 and 52-61, and Group II, associated with claims 38-51, and required restriction of the examination of the present patent to a single disclosed invention for prosecution on the merits. In a telephone conference on September 15, 2005, the Applicant's attorney made a provisional election to prosecute the invention of Group I without traverse. Applicant hereby affirms this election and, as set forth in more detail below, cancels the non-selected claims.

As to the examination of the selected group, the Examiner rejected claims 24-37 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner rejected claims 1, 2, 6-8, 17, 18 and 20-23 under 35 U.S.C. § 102 as being unpatentable over Graham ( U.S. Patent No. 4,640,772). Pursuant to 35 U.S.C. § 103(a), the Examiner rejected claim 3 as being unpatentable over Graham, claims 4 and 5 as being unpatentable over Graham as applied to claim 3 and further in view of Holthius (U.S. Patent No. 4,024,062) and claim 19 as being unpatentable over Graham as applied to claim 1 and further in view of Verdegan, et al. (U.S. Patent No. 6,709,575). The Examiner found claims 52-61 to be allowable and identified claims 24-37 as being allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112, second paragraph. The Examiner objected to claims 9-16 ad being dependent upon a rejected base claim, but identified these claims as being allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claim(s).

21 In response, the Applicant has amended the claims to address the Examiner's rejections  
22 under 35 U.S.C. § 112, second paragraph, and have set forth arguments supporting the patentability  
23 of the claims over Graham and the other cited prior art. The Applicants believe the amendments made  
24 in response to the Examiner's rejections have placed the application in position for allowance.

1      Rejection under 35 U.S.C. § 112

2            With regard to the rejection under 35 U.S.C. § 112, the Applicant is amending claim  
3 24 to comply with the requirements set forth in 35 U.S.C. § 112, second paragraph, in response to the  
4 Examiner's rejection. Specifically, the Examiner noted that claim 24, line 20 references "said one or  
5 more classes of contaminated fluids" without providing antecedent basis. Applicant has amended  
6 claim 24 deleting the phrase "and said one or more classes of contaminated fluids to said more than  
7 one chamber" and replacing it with the phrase into said filter chamber, said particulate fluid into said  
8 settling chamber and said volatile fluid into said volatile chamber" to provide the antecedent basis.  
9 This amendment is supported by the disclosure (i.e., note page 30, line 3 to page 31, line 8) and other  
10 claims (i.e., claims 10 and 52). The Applicant is also amending claim 24 at line 8 to more clearly  
11 identify the term "said fluid" as "said pressurized fluid". The applicant believes that the foregoing  
12 complies with the Examiner's request and that claims 24- 37 are now in allowable condition.

13

14      Rejection under 35 U.S.C. § 102(b)

15            With regard to the rejection of claims 1, 2, 6-8, 17, 18 and 20-23 under 35 U.S.C. §  
16 102(b) as being anticipated by Graham, the Applicants respectfully disagree with the Examiner's  
17 analysis. Graham does not disclose each and every element of Applicant's claimed invention as  
18 required for a Section 102(b) rejection. (See Lineman Maschinenfabrik GMBH v. American Hoist &  
19 Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984); W.L. Gore & Associates, Inc. v. Garlock, Inc.,  
20 220 USPQ 303, 313 (Fed. Cir. 1983).) In particular, Graham does not disclose the multiple chamber  
21 assemblies of Applicant's invention. Nevertheless, Applicant is amending claim 1 to better clarify and  
22 distinguish the present claims from Graham.

23            The oil cleaning assembly detailed in the Graham patent is based on the concept of  
24 utilizing centrifugal force to separate contaminants from lubricating oil. The Graham assembly seeks  
25 to create enough centrifugal force, preferably through the use of a disposable rotor, to separate the  
26 contaminants from the oil. As noted by the Examiner, oil enters the mounting member 1 at inlet 50

1 where it is split, one part going to the centrifugal separator 4 through longitudinal bore 36 and to the  
2 filter 5 through annular oil channel 46. The contaminated portion of the oil separated by the  
3 centrifuge is allowed to drain to the engine's sump (not shown) through passage 55. Filter oil from  
4 the filter 5 passes from spigot 42 through passage 52 to the engine's lubricating rail. Contaminants in  
5 the oil are separated by being forced against the walls of the housing 10 for the centrifugal separator  
6 4. The oil cleaning assembly of Graham appears to only maintain the separation of the oil for as long  
7 as the rotor assembly 25 is kept turning. Because the rotor assembly 25 is kept turning by the  
8 circulation of the engine oil, the logical assumption is that upon turning the motor off, the sludge and  
9 other contaminants would run to the bottom of the centrifugal separator 4. Unfortunately, the  
10 apparatus is designed to return oil from the bottom of the rotor assembly 25 directly back to the  
11 engine, and also bleed off to the filter 5 located below, thereby reducing the effectiveness of the rotor  
12 turning and separation of elements for oil purification and extension of filter life.

13 In the original claim 1 of the present invention, the filter apparatus comprises an inlet to  
14 receive the fluid to be filtered, a centrifugal separator connected to the inlet for separating the  
15 incoming fluid into a separated fluid and one or more classes of contaminated fluids, a chamber  
16 assembly having more than one chamber for receiving and filtering the separated fluid and the  
17 contaminated fluids, a base assembly interconnecting the centrifugal separator and the chamber  
18 assembly and configured to direct the separated fluid and contaminated fluids to the chambers, and an  
19 outlet to discharge the processed fluid. In rejecting claim 1, the Examiner appears to consider the  
20 engine sump as a second filter chamber and references the two filter chambers 5 in Figure 9 of the  
21 Graham patent.

22 The Applicant respectfully disagrees with the Examiner's analysis as to the Graham  
23 patent. The engine's sump is not a chamber that is part of the chamber assembly of the present filter  
24 apparatus. Instead, as set forth in the specification(i.e., at page 30, lines 3-12), as described in use  
25 with an engine to filter lubricating oil, the oil separated from the volatiles and heavier particulate  
26 matter by the centrifugal separator flows to the filter chamber where it is filtered before being

1 discharged out base outlet port 50 to the engine's sump, outside of the filter apparatus of the present  
2 invention. The engine sump is not one of the "more than one chamber" described in claim 1. With  
3 regard to the two filters, both designated as 5, in Figure 9, it appears that both filters serve the same  
4 function as the single filter of the preferred embodiment. No mention is made in the specification, and  
5 none is suggested by the description or the figures, that the two filters do not perform exactly the same  
6 function.

7           Despite the Applicant's position that the original claim 1 is not anticipated by the  
8 Graham patent, the Applicant has nevertheless amended claim 1 to further clarify the present invention  
9 and better distinguish it from the Graham patent. The Applicant is amending claim 1 herein to define  
10 the chamber assembly as specifically having at least a first chamber for receiving and filtering the  
11 separated fluid and a second chamber for receiving and filtering the contaminated fluids. To add  
12 structure to the language of claim 1, the Applicant is also amending claim 1 to include a filter element  
13 in each of the first and second chambers. The Applicant is further amending claim 1 to clarify that the  
14 base assembly directs the separated fluid into the first chamber and the contaminated fluids into the  
15 second chamber. As set forth above, Graham does not disclose each and every element of Applicant's  
16 claimed invention. Further, in order to serve as a reference under 35 U.S.C. § 102(b), the reference  
17 must be enabling as to the features to which anticipation is suggested. (Akzo N.V. v. U.S. Int'l Trade  
18 Comm., 1 USPQ2d 1241, 1245 (Fed. Cir. 1986); In re Donohue, 226 USPQ 619, 621-22 (Fed. Cir.  
19 1985); W.L. Gore & Associates, Inc., 220 USPQ at 314.) Anticipation cannot be predicated on mere  
20 conjecture regarding the characteristics of various features of the invention disclosed in the reference.  
21 (See W.L. Gore & Associates, Inc., 220 USPQ at 314.) With regard to Applicant's invention, as  
22 amended herein, Graham fails to support a 102(b) rejection and, therefore, does not anticipate the  
23 claims Applicant's patent application.

24           Claims 17 and 20 are being cancelled as being incorporated into the amended claim 1.  
25 Claim 21 is being amended to depend from the amended claim 1 instead of the original claim 20,  
26 which is being cancelled. Claims 18, 19, 21 and 23 are being amended herein to correspond to the

27 RESPONSE/AMENDMENT

Appl. # 10/630,947

language of amended claim 1. With regard to the remaining claims rejected under Section 102(b), claims 2, 6-8, 18 and 21-23, these claims are believed to be in allowable condition as depending from an allowable base claim, claim 1, either directly or indirectly.

Rejection under 35 U.S.C. § 103(a)

With regard to the obviousness rejections for claims 3, 4 and 5, which are based on Graham in view of Holthius, Section 103(a) only denies patentability to those inventions whose “subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” (35 U.S.C. § 103.) As set forth above, the teachings from Holthius are not reasonably pertinent to the problems solved by Applicant’s invention. (See In re Clay, 23 USPQ2d 1058, 1060 (CAFC 1992).) Initially, as set forth above, Applicant believes claim 1, as amended, is not anticipated by Graham and, therefore, is in allowable condition. As such, all claims depending from claim 1, including claims 3-5, are also believed to be allowable. In addition, the subject matter and purpose of Applicant’s invention is different than the subject and purpose of the invention in Holthius. Therefore, an inventor would not have been motivated to look to or consider the Holthius patent in attempting to solve the problems solved by Applicant’s invention. (See In re Clay, 23 USPQ2d at 1061.) As a result, a person having ordinary skill in the art would not apply the teachings of Holthius to Graham so as to arrive at Applicant’s invention and nothing in Holthius suggests such an application.

Even if the Holthius reference is considered as analogous art, respectfully, nothing suggests combining the teachings of Holthius with Graham, as suggested by the Examiner, to arrive at Applicant’s invention. As stated by the court in In re Geiger, 2 USPQ2d 1276 (CAFC 1987), “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” (In re Geiger, 2 USPQ2d at 1278.) The motivation or suggestion to combine references must exist, otherwise the determination of obviousness involves nothing more than indiscriminately combining

1 prior art." (Micro Chemical Inc. v. Great Plains Chemical Co., 41 USPQ2d 1238, 1244 (CAFC  
2 1997).) In In re Fritch, 23 USPQ2d 1780 (CAFC 1992), the Federal Circuit stated the following:

3 In proceedings before the Patent and Trademark Office, the Examiner bears the burden of  
4 establishing a *prima facie* case of obviousness based upon the prior art. The Examiner can  
5 satisfy this burden only by showing some objective teaching in the prior art or that knowledge  
generally available to one of ordinary skill in the art would lead that individual to combine the  
relevant teachings of the references.

6 Obviousness cannot be established by combining the teachings of the prior art to produce the  
7 claimed invention, absent some teaching or suggestion supporting the combination. Under  
8 section 103, teachings of references can be combined *only* if there is some suggestion or  
9 incentive to do so. Although couched in terms of combining teachings found in the prior art,  
the same inquiry must be carried out in the context of a purported obvious "modification" of  
the prior art. The mere fact that the prior art may be modified in the manner suggested by the  
Examiner does not make the modification obvious unless the prior art suggested the desirability  
of the modification.

10 Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is  
11 impermissible to use the claimed invention as an instruction manual or "template" to piece  
12 together the teachings of the prior art so that the claimed invention is rendered obvious. This  
13 court has previously stated that one cannot use hindsight reconstruction to pick and choose  
among isolated disclosures in the prior art to deprecate the claimed invention. (In re Fritch, 23  
USPQ2d at 1783-84 (internal quotes and citations removed).)

14 Respectfully, nothing in Holthius, Graham or any knowledge generally available to one  
15 of ordinary skill in the art compels, teaches, suggests or even offers any incentive such that an  
16 individual wanting to invent a filter apparatus utilizing a centrifugal separator to separate the fluid  
17 would look to the strainer device of Holthius for the configuration of the conical rotor and rotor  
18 housing and the use of a generally helical wiper to impart a dredging action and facilitate spinning of  
19 the fluid inside the rotor chamber to better separate the fluid, as described at page 19, lines 6-13. (See  
20 In re Fritch, 23 USPQ2d at 1783; In re Geiger, 2 USPQ2d at 1278.) A person wanting to solve the  
21 problem solved by Applicant's invention (i.e., improved separation of fluid to a chamber assembly for  
22 filtering therein, would not look to a reference (such as the Holthius patent) directed to a strainer that  
23 utilizes the blades to "feed material to the gap between the straining wall and the body of rotation [so  
24 as to] distribute the material uniformly." As a result, viewing the Graham and Holthius references  
25 and determining that it would have been obvious to combine them to achieve Applicant's invention  
26 may, respectfully, be an application of impermissible hindsight to arrive at the determination of

1 obviousness. (See In re Fritch, 23 USPQ2d at 1784.) Applicant believes that, at the time of  
2 Applicant's invention, a person skilled in the art would not have combined these references in this  
3 manner (even assuming one would look to Holthius).

4 With regard to claim 19, like claims 3-5 discussed above, claim 19 depends from the  
5 amended claim 1 and, as a result, is believed to be allowable.

6 In light of the above amendments and arguments, Applicant respectfully requests the  
7 Examiner to withdraw the rejection of the claims set forth in the subject patent application.

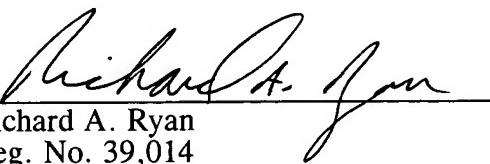
8 Applicant's original application included fees for four (4) independent claims and a total  
9 of 61 claims. The Applicant is cancelling claims 17, 20 and 38-51 and adding no new claims.  
10 Therefore, after this amendment there are a total of 45 claims, including three (3) independent claims  
11 are pending in this application. As such no additional fees for claims are believe due.

12 In view of the foregoing, it is submitted that this application is in condition for  
13 allowance. Reconsideration of the rejections and objections in light of this Amendment is requested.  
14 Applicant believes that the amended claims are in condition for allowance. Allowance of claims 1-16,  
15 18, 19 and 21-37 (52-61 already determined to be allowable) is respectfully solicited.

16

17 Dated: January 23, 2006

18 Respectfully Submitted,

19  
20 By   
Richard A. Ryan  
21 Reg. No. 39,014

22 8497 N. Millbrook, Suite 110  
23 Fresno, CA 93720

24 Phone: (559) 447-1837  
25 Fax: (559) 447-1042  
26 e-mail: richard@fresnopatentlaw.com